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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,459	07/23/2003	Alan E. Stein	ITW7510.054	1458

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ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ITW)
14135 NORTH CEDARBURG ROAD
MEQUON, WI 53097

EXAMINER

KERNS, KEVIN P

ART UNIT PAPER NUMBER

1725

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,459

Applicant(s)

STEIN ET AL.

Examiner

Kevin P. Kerns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 and 17 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: in amended paragraph [0027], 12th line, replace "32" with "36" after "work piece". Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 24-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/605,546. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims include at least the following common features: a welding torch configured to present an electrode to a weld; an enclosure (welder housing); a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank and a spout

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disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls below a certain value; a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system. One of ordinary skill in the art would have recognized that the welder enclosure defined by a base plate, a pair of side plates, a pair of end plates, and a top cover would also be present for the welding-type system of copending Application No. 10/605,546, as it is necessary for the internal components of the welder to be accessible for repairs.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 24-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to amended independent claim 24, the new claim limitation "dump for coolant" lacks support in the originally filed specification, and is thus considered to be new matter. Furthermore, the applicants have not set forth the criticality of this new matter limitation in the originally filed specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 24-43 are rejected (see complete translation of the French text) under 35 U.S.C. 102(b) as being anticipated by Prunier (FR 2 536 320).

Prunier discloses an arc welding machine that includes a refrigeration unit for torch cooling, in which the welding machine further includes a welding torch configured to present an electrode to a weld; an enclosure (welder housing) with a base plate, side plates, end plates, and a top cover; a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank and a spout disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable

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to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls below a certain value; a heat exchanger and water pump assembly (enabling recycled supply -- both a source and dump for coolant); and at least one check valve integrated with the cooling system (abstract; translation of French text of specification and claims; and Figure).

8. Claims 34-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Srba (US 4,942,281).

Srba discloses multi-torch interface assembly for inert gas TIG welding, in which the welding machine further includes multiple welding torches configured to present an electrode to a weld; an enclosure (welder housing) with a base plate, side plates, end plates, and a top cover; a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank (manifold), and a spout disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls below a certain value; a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system (abstract;

column 2, line 42 through column 4, line 61; column 5, line 35 through column 10, line 47; and Figures 1-6).

Response to Arguments

9. The examiner acknowledges the applicants' amendment and replacement drawing sheets received by the USPTO on May 17, 2005. The amendments and replacement drawing sheets overcome prior objections to the drawings, abstract, specification, and claim 31. A minor specification objection remains (see paragraph 1). Provisional double patenting rejections remain (see paragraph 3). A new rejection under 35 USC 112, 1st paragraph has been raised by the amendment (see paragraph 5). The applicants' amendment to claim 24 overcomes the 35 USC 102(b) rejections based on the Srba reference as it applies to claims 24-33 (since Srba has no coolant tank disposed within the same welder housing enclosure as the power conditioner). Claims 24-43 remain under consideration in the application.

10. Applicants' arguments filed May 17, 2005 have been fully considered but they are not persuasive.

With regard to the applicants' remarks/arguments on pages 10-13 of the response, the applicants are referred to paragraph 10 of the prior Office Action (paragraph 7 in this Office Action) to show that the 35 USC 102(b) rejections based on Prunier (FR 2 536 320) was not a result of reliance solely upon the abstract. The "French text of specification and claims; and Figure" are also cited at the end of the

paragraph. It is noted that a complete translation of a foreign document can take up to several weeks to obtain (in this instance about 4 weeks from the Office Action writing date of March 19, 2005 and mailing date of March 24, 2005 -- with the examiner's request for translation date being March 21, 2005). In the future, it is kindly requested that the applicants employ their resources to obtain a complete translation of pertinent foreign documents upon receipt of first and/or subsequent Office Actions to enable a complete reply and hasten prosecution history. However, a complete translation of the French document (which was finally obtained on April 20, 2005) is enclosed with this Office Action. In contrast to the applicants' remarks at the bottom of page 10, the French document includes the limitations of independent claims 24, 34, and 40 -- see translation of French text and the newly underlined portion of paragraph 7. Prunier also discloses that the power conditioner and cooling system is commonly enclosed, in contrast to what the applicants have stated in the last 3 lines of page 10 of their response. Regarding the Srba reference, the applicants are kindly referred to paragraph 8, which continues to include limitations provided in independent claims 34 and 40. Although the rejections of claims 24-33 have been withdrawn due to the applicants' amendment that includes providing the "coolant tank disposed within the enclosure", the examiner respectfully asserts that at least a portion of the "cooling system" is disposed within the enclosure. With regard to independent claim 40 (in response to the applicants' remarks on the bottom of page 13), in particular the newly amended limitation of the check valve that is "biased to a closed bias position" and "configured to automatically overcome the closed bias position...", both references are

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inclusive of valves that are able to be manipulated by hand and by automatic control.

Even if "automatic" control would not be specifically disclosed in the prior art references, the ability for an element to be "automatic" is not a patentable feature by itself, as it has been held that providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192. As a result, all of independent claims 24, 34, and 40 (and claims dependent therefrom) do not patentably distinguish over Prunier and/or Srba.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571)

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272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin P. Kerns *Kevin Kerns 7/17/05*
Primary Examiner
Art Unit 1725

KPK
kpk
July 17, 2005